

Application Serial No. 10/602,198
Amendment Dated April 27, 2007
Reply to Office Action of March 7, 2007

REMARKS

This responds to the third, non-final Office Action dated March 7, 2007. Claims 1, 3, 4, 6, 7, 9, 12, 15, 16, 18, 25, and 27-39 were pending before this amendment. Claims 1, 3, 4, 6, 7, 9, 32-34, 38 and 39 have been cancelled, while claims 12, 16, 25, 29 and 31 have been amended. Claims 40-43 are new. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that the application is in complete condition for allowance and request reconsideration in this regard.

Rejection of claims 1, 3-4, 6-7, 9, 25, and 27 under 35 U.S.C. § 112, ¶ 1

Claims 1, 3-4, 6-7, 9, 25, and 27 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner alleges that the “specification does not disclose a jamb associated with the walls.” Office Action dated March 7, 2007, at 2. Applicants have cancelled claims 1, 3-4, 6-7, and 9, and claim 25 has been amended to delete the recitation of a jamb. Claim 27 depends from claim 25 and does not recite a jamb in any manner. Accordingly, Applicants respectfully submit that the Examiner’s rejection under § 112, first paragraph is now moot and request that it be withdrawn.

Despite the mootness of the Examiner’s rejection, Applicants would like to point out that their amendment does not constitute an admission that the specification does not disclose jambs associated with the walls. The Examiner indicates that “[a]lthough the specification points to number 20 as [a] jamb on page 5, number 20

indeed is showing the surface of the veneer/wall.” Applicants respectfully submit that reference number 20 is both a jamb and a surface of the wall, as those of ordinary skill in the art would appreciate that a “jamb” is merely the portion of a wall defining the vertical sides of an opening in the wall. This is why prior art references like Stanizzo U.S. Patent No. 4,272,931, which was cited by the Examiner elsewhere in the Official Action, describe jamb surfaces as “the inner surface of the window opening perpendicular to the wall and projecting towards the window.” Col. 1, lines 38-40.

Objection to the drawings under 37 C.F.R. § 1.83(a)

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) because, according to the Examiner, the drawings “fail to show the details of the jambs, sill, and overhead as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing.” Office Action dated March 7, 2007, at 2. Applicants have cancelled or amended the claims that previously recited both jambs and walls to eliminate any potential confusion. If these actions are not deemed sufficient to overcome the objection, the Examiner is kindly asked to clarify his remarks.

In any event, Fig. 1 of the present application shows an embodiment of a wall (12) having a window opening (18), which is defined by a pair of jambs (20) (the portions of the wall defining the vertical sides of the opening), a header (22) (the portion of the wall defining the top of the opening), and a sill (24) (the portion of the wall

defining the bottom of the opening). Applicants respectfully submit all structural details essential to a proper understanding of the disclosed invention are shown in Fig. 1 and the remaining figures of the present application. Therefore, for at least the above reasons, Applicants request that the Examiner's objection under 37 C.F.R. § 1.83(a) be withdrawn.

Rejection of claims 1, 7, and 39 under 35 U.S.C. § 112, ¶ 2

The Examiner rejected claims 1, 7, and 39 under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 1, 7, and 39 have been cancelled. Accordingly, Applicants respectfully submit that the rejection of these claims under § 112, second paragraph is moot and need not be addressed herein.

Rejection of claims 12, 15, 18, and 35 as being anticipated by Braun

The Examiner rejected claims 12, 15, 18, and 35 as being anticipated by Braun (5,127,204). As a preliminary matter, Applicants note that this rejection is substantially the same as the rejection in paragraph 2 of the Office Action dated June 1, 2006. Applicants made several arguments to overcome this rejection in the Amendment dated August 31, 2006 (and again in the Supplemental Amendment dated December 7, 2006). The Examiner has not responded to these arguments in any substantive manner. Instead, the Examiner merely asserts that Applicants' arguments "are moot in view of the new ground(s) of rejection." Office Action dated March 7, 2007,

at 12. Although there are new references cited elsewhere in the Office Action, Applicants respectfully submit that the grounds of rejection based on Braun are substantially the same as in the previous Office Action such that Applicants' arguments with respect to Braun still apply. Thus, Applicants will continue to assert substantially the same arguments until the Examiner indicates that the arguments are not persuasive.

For a reference to anticipate the invention in a claim, the reference must teach each and every element in the precise arrangement set forth in the claim. If the reference fails to teach even one of the claimed elements, the reference does not and cannot anticipate the claimed invention. Claim 12 recites a surround device adapted to provide a transition from a wall to a frame mounted in an opening in the wall. The device comprises several elements, including "a first leg adapted for mounting to an outer face of the wall" and "a second leg being adapted to be juxtaposed against the frame and the wall so as to be positioned therebetween and thereby provide a transition from the frame to the wall." Claims 15, 18, and 35 depend from claim 12 and thus include the same recitations. Because Braun fails to disclose both a first and second leg in the manner claimed, Applicants respectfully request that the rejection be withdrawn.

In particular, the Examiner's rejection states that Braun "shows a surround device comprising a first leg (10), a second leg (1a), at least one frangible joint connecting the terminal end portion (4) to a remainder of the second leg, the second leg being more readily broken at the frangible joint than at the remainder of the second leg." However, in col. 3, line 29, Braun states that the element designated by reference

numeral (10) is “contact foam or insulating wool” that merely fills the lateral spacing A between a frame (3) and walling (10) (*see* Fig. 1). Such a foam or wool is not a leg “adapted for mounting to an outer surface of [a] wall,” as required by claim 12. Nor has the Examiner indicated how the terminal end portion (4) of the second leg “is adapted to be removed along the frangible joint to thereby reveal a recess between the frame and the wall at a juncture adjacent to the remainder of the second leg,” as further required by claim 12. Removing the protective tab 4 in Braun instead merely exposes the portion of the door frame 3 over which it extends (*see* col. 3, lines 59-62).

For at least the above reasons, Applicants respectfully submit that Braun fails to disclose each and every recitation claims 12, 15, 18, and 35. Accordingly, Applicants request that the above rejection be withdrawn.

Rejection of claims 12, 15, 35, and 36 as being anticipated by Stanizzo

Claims 12, 15, 35, and 36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stanizzo (4,272,931). Applicants respectfully disagree.

Claim 12, as amended, recites a surround device comprising a first leg adapted to be mounted to an outer face of a wall adjacent an opening in the wall and a second leg “adapted to be juxtaposed against the frame and the wall so as to be positioned therebetween and thereby provide a transition from the frame to the wall.” The second leg includes at least one frangible joint connecting a terminal end portion of the second leg to a remainder of the second leg, “wherein the terminal end portion is

adapted to be removed along the frangible joint and thereby reveal a recess between the frame and the wall at a juncture adjacent to the remainder of the second leg.”

Applicants submit that these aspects are neither shown nor disclosed in Stanizzo.

Instead, Stanizzo discloses a window trim assembly having a casing section (3a) and a border section (3b). The Examiner appears to consider different portions of the border section as the first and second legs recited in claim 12.

Specifically, the Examiner considers “the part with the tongue which is inserted into the groove of part 3a” to be the claimed first leg and “the part immediately perpendicular thereof” to be the claimed second leg. Office Action dated March 7, 2007, at 4. The first leg identified by the Examiner, however, is not “adapted for mounting to an outer face of the wall adjacent to the opening,” as required by claim 12. Moreover, the second leg identified by the Examiner is not “adapted to be juxtaposed against the frame and the wall so as to be positioned therebetween and thereby provide a transition from the frame to the wall,” as further required by claim 12.

Instead, the second leg identified by the Examiner is always positioned in front of the frame (6) in the window opening of the wall (8). *See, e.g.*, Figs. 2 and 3. Thus, removing portions of the so-called second leg along slots (11) (which the Examiner considers as the claimed frangible connections) never reveals any recess “between the frame and the wall.” The frame and the wall in Stanizzo appear to be in contact with each other such that nothing may be inserted therebetween.

Accordingly, for at least the above reasons, Applicants respectfully submit that Stanizzo fails to anticipate claim 12 and request that the rejection claim 12 be withdrawn. Because claims 15, 35, and 36 depend from claim 12, Applicants respectfully submit that Stanizzo fails to anticipate these claims for at least the reasons above as well.

Rejection of claims 12, 15, 35, and 36 as being anticipated by Shaw

The Examiner rejected claims 12, 15, 35, and 36 under 35 U.S.C. § 102(b) as being anticipated by Shaw (4,837,991). Again, Applicants note that this rejection is substantially similar to the Examiner's rejection based on Shaw in the Office Action dated June 1, 2006 such that Applicants' arguments in the Amendment dated August 31, 2006 (and again in the Supplemental Amendment dated December 7, 2006) still apply.

In particular, the Examiner asserts that Shaw discloses "a surround device comprising a first leg (3), a second leg (the leg below section 9 which is next to leg 3, figure 2), at least one frangible joint connecting the terminal end portion (figure 2) to a remainder of the second leg." Once again, however, the Examiner has not indicated how the first leg of Shaw is "adapted for mounting to an outer face" of a wall adjacent to an opening in the wall, as required by claim 12. The first leg in Shaw is instead adapted to define a portion of a cavity (5) beneath a concrete slab poured over the leg (*see* Fig. 2 and col. 4, lines 44-53).

Additionally, the second leg in Shaw is not “adapted to be juxtaposed against the frame and the wall so as to be positioned therebetween and thereby provide a transition from the frame to the wall,” as further required by claim 12. The portion indicated by the Examiner to be the second leg is instead adapted to rest between the vertical surface of a foundation footing and a concrete slab to be poured. *See, e.g.*, Fig. 8 and col. 5, lines 9-42. Thus, the leg will always automatically come into contact with the slab if sufficient concrete is poured, unlike a fixed structure such as a frame. Because Shaw does not disclose each and every limitation in claim 12, Applicants respectfully request that the rejection be withdrawn.

Claims 15, 35, and 36 depend from claim 12 and thus include all of the same recitations as claim 12. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn for at least the reasons above as well.

Rejection of claim 37 as being unpatentable over Braun in view of Jentoft

Claim 37 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Braun in view of Jentoft et al. (4,189,877). To establish a *prima facie* case obviousness under § 103(a), all of the recitations in a claim must be taught or suggested by the prior art. Claim 37 depends from claim 12 and thus includes all of the same recitations as claim 12. As discussed above, Braun fails to disclose a first leg “adapted for mounting to an outer surface of the wall” and a second leg having a terminal end portion “adapted to be removed along [a] frangible joint to thereby reveal a recess

between the frame and the wall at a juncture adjacent to the remainder of the second leg.” Nothing in Jentoft cures this deficiency (the Examiner merely relied on Jentoft as disclosing perforations). Accordingly, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness and request that the rejection of claim 37 be withdrawn.

Rejection of claims 1, 3-4, 6, 9, 12, 15, 25, 27-28, and 30 as being unpatentable over Anastasi in view of Northrup and Stanizzo

The Examiner rejected claims 1, 3-4, 6, 9, 12, 15, 25, 27-28, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Anastasi (6,244,001) in view of Northrup Jr. (5,473,851) and Stanizzo. Because claims 1, 3-4, 6, and 9 have been cancelled, the rejection of these claims is moot and will not be addressed herein. With respect to the remaining claims, Applicants respectfully disagree with the rejection for several reasons.

First, claims 12 and 25, which are the only independent claim of this rejection that remain pending, each recite a second leg being or adapted to be “juxtaposed against the frame and the second wall.” Being juxtaposed against both of these components helps provide a solid support for a backer rod and caulk (78) or other filling material used to fill the recess (76) after the terminal end portion (68) is removed (see Figs. 5A and 6 of the application). Applicants respectfully submit that none of the references cited by the Examiner disclose a second leg being juxtaposed in such a manner.

In particular, Anastasi discloses a flashing comprising a first panel (12), second panel (14), and third panel (16). The Examiner cited the third panel (16) as being the second leg recited in claims 12 and 25. Although the panel (16) may be adapted to engage a side surface (96) of the window frame (90) (*see* Fig. 3), the panel (16) is not juxtaposed against both the frame (90) and the wall (68). As such, when a sealant system or backer rod (85) is inserted into the space between the panel (16) and wall structure (68), there is no support provided by the Anastasi device. Applicants' device as recited in the claims 12 and 25 fills the lateral void between the frame and the wall and provides structure against which a backer rod and sealant can be installed. Applicants pointed this deficiency of Anastasi out to the Examiner in the Amendment dated August 31, 2006 (and again in the Supplemental Amendment dated December 7, 2006). The Examiner has not, however, responded to Applicants' remarks or indicated how Northrup or Stanizzo cures this deficiency.

Indeed, the Examiner merely relies on Northrup as disclosing masonry units held together with mortar and Stanizzo as disclosing a frangible connection joining the terminal end portion to a remainder of a second leg. Neither of these references discloses a second leg being juxtaposed to both a frame and a wall. Accordingly, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness and request that the rejection of claims 12 and 25 be withdrawn.

Because claims 27-28 and 30 depend from claim 25, Applicants respectfully submit that the Examiner has not established a *prima facie* case of

Application Serial No. 10/602,198
Amendment Dated April 27, 2007
Reply to Office Action of March 7, 2007

obviousness with respect to these claims for at least the reasons above. Therefore, Applicants request that the Examiner withdraw the rejection of claims 27-28 and 30 as well.

Rejection of claims 1, 3-4, 6, 25, 27-28, and 31-33 as being unpatentable over Anastasi in view of Northrup and Stanizzo

Claims 1, 3-4, 6, 25, 27-28, and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anastasi in view of Northrup and Stanizzo. Applicants note that this is the same combination of references cited by the Examiner in the rejection above. The Examiner applies the references in the same manner as in the above rejection such that the arguments above with respect to claims 25, 27 and 28 apply equally to this rejection. Additionally, because claims 1, 3-4, 6, 32 and 33 have been cancelled, the rejection of these claims is moot and will not be addressed herein. This leaves claim 31, which Applicants submit is not rendered obvious under § 103(a) by the combination of references cited by the Examiner.

In particular, claim 31 has been amended to recite the subject matter of claim 39, which has been cancelled. Because claim 39 was not subject to this rejection, Applicants respectfully submit that claim 31, as amended, is patentable over the combination of references cited by the Examiner. Accordingly, Applicants request that this rejection of claim 31 be withdrawn.

Application Serial No. 10/602,198
Amendment Dated April 27, 2007
Reply to Office Action of March 7, 2007

Rejection of claims 7, 9, 16, 18, and 29-30 as being unpatentable over Anastasi in view of Northrup, Stanizzo, Trout, and Jentoft

Claims 7, 9, 16, 18, and 29-30 stand rejected as being unpatentable over Anastasi in view of Northrup, Stanizzo, Trout (6,993,874), and Jentoft. Because claims 7 and 9 have been cancelled, the rejection of these claims is moot and will not be addressed herein. Of the remaining claims in the rejection, claims 16 and 29 are independent, claim 18 depends from claim 16, and claim 30 depends from independent claim 25 (which is not subject to the rejection). Applicants respectfully submit that the combination of references cited by the Examiner fails to teach or suggest all of the recitations in these claims.

In particular, claim 16 as been amended so that it is patterned off independent claim 12 but further recites the second leg of the surround device being “a closed cell foam material” and the frangible joint comprising “perforations.” Applicants need not address whether the references cited by the Examiner disclose these additional recitations because, in any event, none of the references disclose the “second leg” recited in claim 16. Claim 16, like claim 12, recites a second leg of a surround device “adapted to be juxtaposed against the frame and the wall so as to be positioned therebetween.” Claim 16 also recites the second leg having a terminal end portion and a frangible joint connecting the terminal end portion to a remainder of the second leg, “wherein the terminal end portion is adapted to be removed along the frangible joint and thereby reveal a recess between the frame and the wall at a juncture adjacent to the remainder of

the second leg.” As discussed above with reference to claim 12, Anastasi does not teach these recitations and Northrup and Stanizzo fail to cure this deficiency. Applicants respectfully submit that Trout and Jentoft, which were merely relied upon by the Examiner as disclosing closed cell foam and perforations, fail to cure this deficiency as well. Accordingly, Applicants request that the rejection of claim 16 be withdrawn for at least this reason.

Claim 18 depends from claim 16 and thus includes all of the same recitations as claim 16. Thus, Applicants request that the rejection of claim 18 be withdrawn for at least the above reasons as well.

Claim 29 has been amended so that it is patterned of independent claim 25 but further recites “wherein the second leg is a closed cell foam material, the frangible joint comprises perforations in the closed cell foam material, and the first and second legs are of dissimilar materials bonded together.” Once again, Applicants need not address whether the references cited by the Examiner teach these additional recitations because, in any event, none of the references disclose the “second leg” recited in claim 29. Claim 29, like claim 25, recites a generally L-shaped device having first and second legs, with the second leg being “juxtaposed against the frame and the second wall.” As discussed above with reference to claim 25, Anastasi does not teach these recitation and Northrup and Stanizzo fail to cure this deficiency. Applicants respectfully submit that Trout and Jentoft, which were merely relied upon by the Examiner as disclosing closed

Application Serial No. 10/602,198
Amendment Dated April 27, 2007
Reply to Office Action of March 7, 2007

cell foam and perforations, fail to cure this deficiency as well. Accordingly, Applicants request that the rejection of claim 29 and be withdrawn for at least the reasons above.

Claim 30 depends from claim 25 and thus includes all of the same recitations as claim 25. Thus, Applicants request that the rejection of claim 30 be withdrawn for at least the above reasons as well.

Rejection of claim 34 as being unpatentable over Anastasi in view of Northrup, Stanizzo, and Jentoft

Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Anastasi in view of Northrup, Stanizzo, Trout, and Jentoft. Because claim 34 has been cancelled, Applicants submit that this rejection is now moot and need not be addressed herein.

Rejection of claims 38 and 39 as being unpatentable over Anastasi in view of Northrup, Stanizzo, and Ting

Claims 38 and 39 stand rejected as being unpatentable over Anastasi in view of Northrup and Stanizzo as applied to claims 1 or 31 and further in view of Ting (5,596,851). Because claims 38 and 39 have been cancelled, Applicants submit that the rejection of these claims is now moot and need not be addressed herein.

Application Serial No. 10/602,198
Amendment Dated April 27, 2007
Reply to Office Action of March 7, 2007

CONCLUSION

Applicants respectfully submit that the foregoing is a full and complete response to the Office Action dated March 7, 2007. Applicants also respectfully submit that the pending claims are patentable for the reasons discussed above. If the Examiner believes any matter requires further discussion, the Examiner is invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicants believe that no fees are due in connection with this response. If such petition is due or any fees are necessary, however, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

_____/Keith R. Haupt/
Keith R. Haupt
Reg. No. 37,638

2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202
(513) 241-2324 (voice)
(513) 421-7269 (facsimile)
khaupt@whepatent.com
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#57682v1